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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,719	10/03/2005	George Tiri Tomka	05-231	9101
20306 7590 09/06/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER HARRIS, GARY D	
			ART UNIT 1773	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,719	Applicant(s) TOMKA ET AL.	
	Examiner Gary D. Harris	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/03/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 2, 5, 6, 7, 8, 9, 10 & 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Davies US 5,582,924.

As to Claim 1, Davies '924 describes a magnetically activated tag made by electroless deposition of soft magnetic material (Col. 1, Line 62-65).

As to Claim 2, Davies '924 discloses the use of catalyst and examiner considers this to be a promoter and therefore meet the limitations of claim language (Col. 2, Line 3).

As to Claim 5, Davies '924 discloses deposition of soft magnetic material and electroless deposition for use on a tag (Col. 1, Line 9-11 & 26-29).

As to Claim 6, although Davies '924 does not claim a biasing field, applicant has not described the limits of the biasing field and in the broadest sense; earth's magnetic field would be a bias the electroless deposition reaction.

As to Claim 7, Davies '924 discloses the limitations of the claim.

As to Claim 8, Davies '924 discloses the use of hard and soft magnetic materials (Col. 1, Line 26-33). The patentability of a product is independent of how it was made. Ex parte Jungfer 18 USPQ 1796, 1800 (BPAI 1991); Bristol-Myers Co. v. U.S. International Trade Commission 15 USPQ 2d 1258 (Fed. Cir. 1989). The burden is on applicants to show product differences in product by process claims. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

As to Claim 9 &10, Davies discloses the use of patterned hard and soft magnetic materials (Col. 3, Line 56-65) and the use of heat treatment that would affect the magnetic bias (Col. 3, Line 35-40). A magnetic bias would be an inherent feature of the materials, as two different magnetic materials would naturally bias one another. Because the applicants and the inventors teach virtually identical structures with similar materials they would be inherently the same. The physical properties of similar materials will inherently be similar. The burden of proof is shifted to the applicant to show the prior art properties are different from those claimed. See In re Fitzgerald, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980).

As to Claim 11, Davies discloses a magnetic tag with information bits made from soft and hard magnetic materials. The patentability of a product is independent of how it was made. Ex parte Jungfer 18 USPQ 1796, 1800 (BPAI 1991);

Brystol-Myers Co. v. U.S. International Trade Commission 15 USPQ 2d 1258 (Fed. Cir. 1989). The burden is on applicants to show product differences in product by process claims. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 & 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Davies US 5,582,924 in view of Chou et al. US 5,322,751.

As to Claim 3 & 4, Davies '924 discloses the use of printing as a mask for the use of screen printing, roller or suitable pattern and the application of nonmagnetic materials, Davies '924 does not disclose deposition promoting materials by print transfer mechanism including ink-jet. However, Chou '751 discloses metallic coatings being transferred using printing techniques and electroless plating solutions (Col. 14, 15, Line 60-69, 1- 11 respectively). It would be obvious to one skilled in the art to use the method

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of Chou '751 in the Davies invention in order to apply a second metallic coating (Col. 21, Line 59-66).

Column and line numbers are provided for convenience. However the entire reference should be considered.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure US PGPub 2003/0180451, 20030175411, 2003/0108664.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary D. Harris whose telephone number is 571-272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH



CAROL CHANEY
SUPERVISORY PATENT EXAMINER